

R E M A R K S

Reconsideration of the application in view of the above amendments and following remarks is respectfully requested. Claims 1, 8, 15, 25, 35 and 41 have been amended. Therefore, claims 1-45 are pending in the application.

Supplemental Information Disclosure Statement

Enclosed herewith is a Supplemental Information Disclosure Statement (IDS). Applicant respectfully requests that the Examiner consider, initial, and return a copy of the PTO/SB/08A and PTO/SB/08B to Applicant.

Written Statement regarding Substance of 10/31/05 Interview per 37 CFR 1.133(b)

Applicants originally requested to have a telephone interview with both Examiner Phan and Supervisory Examiner Vanderpuye on November 1, 2005. However, on October 31, 2005, Examiner Phan telephoned the undersigned and indicated that the interview scheduled for November 1, 2005, would be cancelled. The Examiner then proceeded to conduct the below described interview.

Applicants appreciate very much the opportunity to discuss the rejections in this application with Examiner Hanh Phan in the telephone interview that occurred on October 31, 2005. In accordance with the requirements of 37 CFR 1.133(b), and the Manual of Patent Examining Procedure (MPEP) §713.04, Applicants provide the following written statement of the reasons presented at the interview as warranting favorable action.

No exhibits were shown or discussed. The claims that were discussed were independent claims 1, 8, 15, 25, 35 and 41. The prior art that was discussed was German Patent No. DE

4433896 C1 to Vollert ("Vollert"), U.S. Patent No. 4,904,993 to Sato ("Sato"), and U.S. Patent No. 6,812,881 to Mullaly et al. ("Mullaly et al.").

The general thrust of the Applicants' principal argument that was to be discussed in the interview was that the Examiner has not responded to the argument that Applicants made in their last response dated May 9, 2005, that Vollert teaches directly against the proposed modification. That is, even if Mullaly et al. discloses "wherein an RF transceiver for generating the RF signal is active during the active mode" as alleged by the Examiner, it would still not be obvious to incorporate this limitation into Vollert because Vollert teaches directly against such a modification. This is because Vollert teaches directly against having his radio transmitters be active while information is being exchanged over his infrared transmission path.

The Examiner indicated early in the interview that he would withdraw all of the rejections under 35 U.S.C. § 103(a). The Examiner apparently decided to withdraw these rejections during his review of the case prior to the interview. Thus, agreement with respect to the claims was reached in that the Examiner agreed to withdraw all of the rejections under 35 U.S.C. § 103(a).

The Examiner indicated that after Applicants filed a response to the Final Office Action mailed August 8, 2005, the Examiner would conduct an updated search. With respect to proposed amendments, the Examiner suggested that the current language of claim 1 that the RF transceiver "is active during the active mode" appeared to be broad to the Examiner. The Examiner suggested that this language be amended to indicate that the RF transceiver is actually transmitting something. As discussed below, Applicants have followed this suggestion in an effort to advance this application to allowance.

Allowable Subject Matter

Applicants appreciate the Examiner's indication that claims 6, 13, 23, 33, 39 and 44 would be allowable if rewritten in independent form and to overcome the double patenting rejections. Applicants have not rewritten these claims in independent form at this time but reserve the right to do so later.

Double Patenting Claim Rejections

I. The Examiner rejected claims 1-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 6,763,195 to Willebrand et al. (the parent application hereto). Applicants respectfully traverse these rejections.

In order to overcome this rejection, a Terminal Disclaimer in compliance with 37 CFR 1.321(c) is included herewith. A Fee Transmittal form is also included herewith to cover the Terminal Disclaimer fee.

Applicants submit that U.S. Patent No. 6,763,195 is commonly owned with the present application. Namely, the entire right, title and interest in the invention and application that issued as U.S. Patent No. 6,763,195 is assigned to LightPointe Communications, Inc. The assignment is recorded in the USPTO at the reel/frame 010720/0742. Since the present application is a continuation of U.S. Patent No. 6,763,195, it is also assigned to LightPointe Communications, Inc. Therefore, Applicants submit that they have shown that U.S. Patent No. 6,763,195 and the present application are commonly owned.

Therefore, this double patenting rejection should be withdrawn.

II. The Examiner rejected claims 1-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,889,009 to Willebrand (the '009 patent). Applicants respectfully traverse these rejections.

Applicants assert that this double patenting rejection is clearly improper and must be withdrawn. The rejection is improper for at least two reasons.

First, the Examiner has simply not provided the detailed analysis that is required for an obviousness-type double patenting rejection. Specifically, Section 804 of the Manual of Patent Examining Procedure (MPEP) states:

"Any obviousness-type double patenting rejection should make clear: (A) The differences between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim **>at issue would have been< an obvious variation of the invention defined in a claim in the patent. When considering whether the invention defined in a claim of an application *>would have been< an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art."

(MPEP § 804 Definition of Double Patenting) (emphasis added).

The Examiner has not identified the differences between the inventions defined by the claims in the present application as compared to the claims in the '009 patent. Furthermore, the Examiner has not provided the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims of the present application would have been an obvious variation of the invention defined in the claims of the '009 patent. Instead, the Examiner simply states "see

claims 1-7 of US Patent No. 6,889,009". Applicants assert that this is inadequate to support an obviousness-type double patenting rejection. Therefore, the rejections should be withdrawn.

A second reason that the rejections are improper is that the Examiner does not appear to be applying the correct test for determining an obviousness-type double patenting rejection. Specifically, the Examiner states that claims 1-45 of the instant application "are encompassed" by claims 1-7 of U.S. Patent No. 6,889,009. In this regard, Section 804 of the MPEP states:

"Domination and double patenting should not be confused. They are two separate issues. One patent or application 'dominates' a second patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination by itself, i.e., in the absence of statutory or nonstatutory double patenting grounds, cannot support a double patenting rejection."

(MPEP § 804 Definition of Double Patenting) (emphasis added).

The test is not whether the claims of the present application are "encompassed" by the claims of the '009 patent. Instead, the Examiner must provide the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claims of the present application would have been an obvious variation of the invention defined in the claims of the '009 in the patent. Because the Examiner has not done this, the rejections must be withdrawn.

Therefore, Applicants assert that the double patenting rejections based on the '009 patent must either be withdrawn, or the Examiner must (1) identify the differences between each of the claims in the present application as compared to each of the claims in the '009 patent; and (2) provide the reasons

why a person of ordinary skill in the art would conclude that the each of the claims of the present application would have been an obvious variation of each of the claims of the '009 patent.

III. The Examiner provisionally rejected claims 1-45 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of copending U.S. Application No. 10/646,994 to Willebrand et al. Applicants respectfully traverse these rejections.

In order to overcome this provisional rejection, a Terminal Disclaimer in compliance with 37 CFR 1.321(c) is included herewith. A Fee Transmittal form is also included herewith to cover the Terminal Disclaimer fee.

Applicants submit that Application No. 10/646,994 is commonly owned with the present application. Namely, both applications are continuations of U.S. Patent No. 6,763,195. The entire right, title and interest in the invention and application that issued as U.S. Patent No. 6,763,195 is assigned to LightPointe Communications, Inc. The assignment is recorded in the USPTO at the reel/frame 010720/0742. Therefore, Applicants submit that they have shown that Application No. 10/646,994 and the present application are commonly owned.

Therefore, this double patenting rejection should be withdrawn.

Claim Rejections under 35 U.S.C. § 103

The Examiner rejected claims 1-5, 7-12, 14-22, 24-32, 34-38, 40-43 and 45 under 35 U.S.C. § 103(a) as being unpatentable over German Patent No. DE 4433896 C1 to Vollert ("Vollert") in view of U.S. Patent No. 4,904,993 to Sato ("Sato"), and further in view of U.S. Patent No. 6,812,881 to

Mullaly et al. ("Mullaly et al."). Applicants respectfully traverse these rejections.

As mentioned above, the Examiner indicated in the telephone interview of October 31, 2005, that he decided to withdraw all of the rejections under 35 U.S.C. § 103(a) in view of the arguments that Applicants were going to present in the interview. Therefore, all of these rejections have been withdrawn.

Even though all of the § 103 rejections have been withdrawn, Applicants have nevertheless amended the independent claims in the manner suggested by the Examiner in the telephone interview of October 31, 2005. Applicants have done this in an earnest effort to advance this application to allowance.

Specifically, Applicants have amended independent claim 1 to recite wherein an RF transceiver for generating the RF signal is active during the active mode "and transmitting". The other independent claims have been amended in a similar manner. Applicants assert that these amendments are well supported by Applicants' specification and drawings, such as for example at page 11, line 29 to page 12, line 16, as well as numerous other portions of the specification.

Applicants assert that these amendments should satisfy any concerns the Examiner might have about the previous language being overly broad. Therefore, Applicants assert that the claims are now in a condition for allowance.

Fees Believed to be Due

No extra claims fees are believed to be due. A fee and transmittal for a Request for Continued Examination (RCE) and Terminal Disclaimers may be charged to deposit account number 06-1135 to Fitch, Even, Tabin & Flannery.

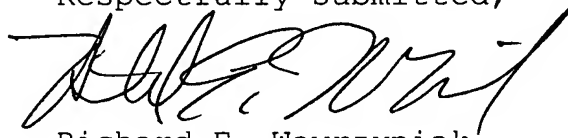
App. No.: 10/840,172
Amendment

C O N C L U S I O N

Should there be any outstanding issues that require adverse action with respect to this amendment, it is respectfully requested that the Examiner telephone Richard E. Wawrzyniak at (858)552-1311 so that such issues may be resolved as expeditiously as possible.

Dated 11/8/05

Respectfully submitted,



Richard E. Wawrzyniak
Reg. No. 36,048

Address all correspondence to:

Richard E. Wawrzyniak, Esq.
FITCH, EVEN, TABIN & FLANNERY
120 So. LaSalle Street, Suite 1600
Chicago, Illinois 60603
Customer No. 22242
Telephone No.: (858) 552-1311
Facsimile No.: (858) 552-0095